

REMARKS/ARGUMENTS

This Preliminary amendment is submitted with a Request for Continued Examination (RCE) in response to the Examiner's Advisory Action dated April 15, 2005. Claims 1-35 are pending in the present Application. Claims 1, 10, 23, and 31-33 were amended, and claims 36-40 were added. Consequently, claims 1-40 are now pending.

Claim Amendments

Independent claims 1, 10, and 23 were amended to recite a method and online photo sharing service "for providing access to" entity-specific photo-sharing web sites, rather than for "hosting" entity-specific photo-sharing web sites. Independent claims 1, 10, and 23 were also amended to require (with slight variation) that the image capture device is connected to the photo-sharing service "via the network."

Support for "providing access" and the new claims can be found in the Specification, see for example, the paragraph on page 12, lines 5-12, and in the paragraph bridging pages 14 and 15, each of which is repeated below for convenience.

"If, for example, a third party developer X contracts to provide custom camera software for camera manufacturer Z, then a custom entity ID will be issued for developer X and developer X will place the custom entity ID into the EEPROM 82b. Developer X is now a controlling entity 12, and may specify to the photo-sharing service 16 that a developer X entity-specific photo-sharing site 22 **or developer X's own website be the destination for the uploaded images.**"

"In a further aspect of the present invention, an action list item is not limited to instructing the gateway server 18 to perform actions only within the photo-sharing service 16. **Rather, an item in the action list 48 may also instruct the gateway server 18 to perform actions outside of the photo-sharing service 16, such as storing the images in an external database 49 of the entity 12. For instance, in the example where the entity 12 is a company, some users of the company's**

cameras 14 could have action lists 48 instructing the gateway server 18 to store uploaded images to the company's database, rather than to the company's photo-sharing site 22."

Accordingly, it is respectfully submitted that no new matter has been entered.

§103 Rejections

In the Final Office Action dated December 13, 2004, the Examiner rejected claims 1-30 and 34-35 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,017,157 (Garfinkle) in view of U.S. Patent No. 6,581,094 (Gao). The Examiner rejected claims 31-33 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,017,157 (Garfinkle) in view of U.S. Patent No. 6,581,094 (Gao), and further in view of U.S. Patent No. 6,035,323 (Narayan).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP §2142.

When responding to Applicant's previous arguments, the Examiner stated "combining the teachings of Garfinkle et al. with the teachings of Gao would disclose a [sic] 'online-sharing' system that can transmit digital photos over the Internet (See Garfinkle et al.) providing a device ID (See Gao)" (Final Office Action, paragraph 6). It is respectfully submitted that the Examiner has failed to present a prima facie case of obviousness because 1) a combination of Garfinkle and Gao fail to teach or suggest the use of "entity IDs" that identify entity specific photo-sharing websites, as recited in claims 1 and 23, 2) there is no motivation to combine Garfinkle and Gao, and 3) the combination fails to teach or suggest an image capture device that can communicate with a photo-

sharing service/website and transmit images and entity ID's via a network, as recited in claims 1, 10, and 23.

Gao fails to teach or suggest "entity IDs" that identify entity specific photo-sharing websites

Applicant's agree with the Examiner's statement in paragraph 3 of the Final Office Action that "Garfinkle does not teach a method for hosting entity-specific photo-sharing websites for entity-specific image capture devices, comprising the steps of: providing software for the entity-specific image capture devices that causes the entity-specific image capture devices to transmit entity ID information when the image capture devices transmit images over the Internet; such that when the image capture devices connect to photo-sharing service, the photo-sharing service uses the entity ID received from the image capture devices to automatically associate the images to the photo-sharing website of the identified entity."

Gao, however, fails to remedy the defects of Garfinkle. Gao describes a system for identifying a digital device based a uniform device descriptor file that specifies the attributes of the device in an XML document in a networked environment. The system of Gao includes clients, a server, and a digital appliance. The digital appliances are not clients or servers, but are apparently devices that can typically be coupled to a network such as printers, faxes, digital copiers, pagers, or PDAs. Gao, col. 3, line 62-col. 4, line 4. In order to support devices having different operating and connectivity schemes, a Uniform Device Descriptor is associated with each digital device that characterizes a set of attributes associated with its corresponding digital device.

Gao fails to teach or suggest that "the photo-sharing service uses the entity ID received

from the image capture devices to automatically associate the images to the photo-sharing website of the identified entity,” as recited in claim 1 and similarly in claim 23. Although the claimed entity ID may be stored on the device and may include device information (with hierarchical entity IDs), ultimately, the entity ID is used to identify the **website** to which the images are associated, not the device used to upload the data. In contrast, Gao’s Uniform Device Descriptor file is used to identify the **device** being connected to the network. Since Gao’s XML files are used to identify their respective **devices**, they cannot be said to be entity IDs used to identify the website to which the images are associated, as claimed.

Lack motivation to combine Garfinkle and Gao

It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). It is respectfully submitted that there is no motivation, express or implied, for combining the teaching of the references to produce the present invention as claimed.

In the Final Office Action, the Examiner states as motivation that the combination “would allow easy identification of digital devices within a network environment and fully exploit the use of that digital device”. The Examiner also states that the combination “would make it easier for a user to interact with the device via the Internet”. But the claimed invention is not directed to any of these goals. Identification of the devices (i.e., the camera or capture device) is not central to the invention. Instead, identification of the entity-specific website (e.g., via the entity

ID) is featured in the claimed subject matter. Thus, the motivation to combine the cited documents stated by the Examiner in the Final Office Action is insufficient to support the obviousness rejection of claims 1, 10, and 23.

Even if the references were combined, however, there would be little expectation for success because the combination would fail reach the claimed invention or function as claimed. For example, if the **device-identifying** information in Gao's XML file were to be combined with Garfinkle as the Examiner suggests, then Garfinkle's cameras would upload to the server, via the user's PC, the camera's Uniform Device Descriptor file that identifies the camera attributes. The server would then use the descriptor file to identify the camera and its attributes and then store any uploaded images in a website. However, because only the device is identified, and not the entity (e.g., the user or the business providing the website), every user of a like device would have their images uploaded to the very same website.

In the claimed invention, there are different photo-sharing web sites for different entities, and each entity ID is used to associate the images from a particular image capture device with the website of the corresponding entity. More particularly, page 6 of the specification states:

As used herein, a camera controlling entity 12 is any entity that makes, owns, sells, or controls digital cameras 14, and therefore includes, camera manufactures, companies, retailers, and end-users. One or more combination of these entities 12 may either contract with the photo-sharing service 16 to provide entity-specific websites 22 for their cameras 14, or have entity information transmitted to the photo-sharing service 16 from the cameras 14. Therefore, a camera controlling entity 12 may include a single entity 12 or a hierarchal relationship of entities 12.

An example of a single entity 12 includes an insurance company that contracts with the photo-sharing service 16 to have all digital cameras 14 used by their agents to transmit their images to a customized insurance photo-sharing website. Examples of a hierarchal relationships of entities 12 includes a camera manufacturer, such as Nikon, that contracts with the photo-sharing service 16 to

have all Nikon digital cameras 14 transmit their images to the customized Nikon photo-sharing website. Since the images of different users must be distinguished, each user of a Nikon camera 14 would also constitute an entity within the Nikon website so that the images from different users can be distinguished. Other examples of hierarchical entity relationships include a retailer and its consumers, a real estate agency and its agents, community groups and its members, and government agencies and its employees, for instance.

Thus, even though entities can be hierarchical, ultimately, the entity IDs must reference the website to which the uploaded images are to be stored. The combination of Garfinkle and Gao fail to provide this functionality. That is, Garfinkle and Gao fail to teach or suggest “entity-specific image capture devices” that “transmit entity ID information when the image capture devices transmit images over a network”, “such that when the image capture devices connect to the photo-sharing service via the network, the photo-sharing service uses the entity ID received from the image capture devices to automatically associate the images to the photo-sharing website of the identified entity,” as recited in claim 1.

Garfinkle fails to teach or suggest a digital camera capable of network communication

Claims 1, 10, and 23 have been amended to make more clear that the image capture device is connected to the photo-sharing service via a network. This is what was meant by Applicant's previous argument regarding the image capture device is being directly connected to the photo-sharing service. The term “direct” is not recited in the claims because Applicant recognizes that other networking devices can be included in the path between the capture device and the photo-sharing service.

Garfinkle's digital camera, however, is incapable of network communication, and must instead rely on the user's PC for network communication and to upload images. Therefore,

Garfinkle fails to teach or suggest “an image capture device that “transmit[s] entity ID information **when the image capture devices transmit images over a network,**” as recited in claim 1; “digital camera software that is customized for each of the entities, such that when the software customized for a particular entity is executed in the entity’s digital cameras during a network connection to the photo-sharing service, the **software causes the digital cameras to automatically upload images to the website** for that particular entity,” as recited in claim 10; and the step of “**providing a plurality of cameras with means for allowing the cameras to communicate over a network**” as recited in claim 21.

The Examiner relies on column 5, lines 11-29 of Garfinkle for “disclosing several methods of distributing digital photos,” and FIG. 9B and column 2, lines 61-64 of Garfinkle for “teaching a direct connection between photographer and uploading the photographic image to an image server.”

Column 5, lines 11-29 merely describe that “...the photographer 8 accesses HTML pages from a WWW browser... the Netscape server is configured with an HTML forms interface which accepts the unique access code and provides access to thumbnails... of images in the role in the form of an online proof sheet.” Insofar as this passage describes a photographer accessing thumbnails on a web page, this passage wholly fails to teach or suggest a digital camera that “communicates over a network” to “upload images” and “entity ID information” to a “website”, as claimed.

Although in column 2, lines 61-64, Garfinkle states “[i]n an alternative embodiment, a digital image from a digital camera of the photographic image is uploaded directly to one or more image server 16, see FIG. 9B”, this passage must be taken in the context of Garfinkle's disclosure as a whole. When Garfinkle states that the digital image is uploaded “directly”, Garfinkle means

without needing to have a film image scanned before uploading the digital image to the image server 16 as shown in FIG. 9A. Nowhere does Garfinkle teach or suggest that the digital camera can “communicate over a network” and “upload image to a website,” as claimed. Indeed, Garfinkle’s FIG. 9B clearly shows that the digital image data in the camera 9a must be transferred to a PC (or other computer) in order to be uploaded to the image server 16.

Based on above, the only reasonable interpretation of Garfinkle is that the images from a digital camera are uploaded to another computer, which is then used to upload the images to the image server. Consequently, Garfinkle fails to teach or suggest a system whereby an image capture device/digital camera “communicates over a network” and “upload[s] images” and “entity ID information” to a “online photo-sharing service” or other “website”, as recited in independent claims 1, 10, and 23.

Thus, a combination of Garfinkle and Gao would fail to solve one problem that the claimed invention overcomes: how to associate images uploaded to a photo-sharing service from digital cameras of different entities with the websites of the corresponding entities. Accordingly, the combination of Garfinkle and Gao fails to teach or suggest all the limitations of claims 1, 10, and 23, lacks some suggestion or motivation to modify the reference or to combine reference teachings fail, and therefore fails to provide a prima facie case of obviousness.

Accordingly, it is respectfully submitted that independent claims 1, 10, and 23 are allowable over the cited references for these reasons as well.

Dependent Claims 31-40

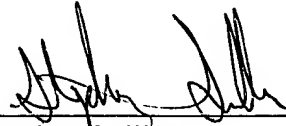
The arguments made above with respect to independent claims 1, 10 and 23 apply with

full force and effect to dependent claims 31-40. Therefore the claims 31-40 are allowable for at least the same reasons as 1, 10 and 23.

Consequently, Applicant respectfully submits that claims 1-40 are allowable over the cited references. Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

SAWYER LAW GROUP LLP

A handwritten signature in black ink, appearing to read 'Stephen Sullivan', is written over a horizontal line.

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Date